

### **REMARKS**

Claims 1-84 are pending in this application, with claims 1, 54, 63 and 72 being independent.

In the final Office Action of September 6, 2007 ("Office Action"), claims 21 and 52 were rejected under 35 U.S.C. § 112, second paragraph; claims 1-4, 7, 8, 18-32, 35-43, 47-55, 57, 58, 60-64, 66-67 and 69-84 were rejected under 35 U.S.C. § 103(a) based on U.S. Patent No. 5,880,731 ("*Liles*") and U.S. Patent No. 5,880,731 ("*Tang*"); claims 5, 6, 9-17, 56, 59, 65 and 68 were rejected under 35 U.S.C. § 103(a) based on *Liles*, *Tang* and WO 01/84461 A1 ("*Kim*"); claims 33 and 34 were rejected under 35 U.S.C. § 103(a) based on *Liles*, *Tang* and U.S. Patent No. 7,007,065 ("*Matsuda*"); and claims 44-46 were rejected under 35 U.S.C. § 103(a) based on *Liles*, *Tang* and U.S. Patent No. 7,177,811 ("*Ostermann*"). These rejections are addressed below.

#### **Section 112 rejection**

The Office Action asserts that claims 21 and 52 are indefinite because of the term "substantially" recited in the claims. *See* Office Action, p. 2. According to the Office Action, the term is not defined in the claim, the specification does not provide a standard, and one of ordinary skill would not be reasonably apprised of the scope of the claim. *See id.* Applicants traverse the section 112 rejection for the following reasons.

According to section 2173.02 of the M.P.E.P., "[t]he essential inquiry pertaining to this requirement [of definiteness] is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity." M.P.E.P. § 2173.05(b) states:

The fact that claim language, including terms of degree, may not be precise, does not automatically render the claim indefinite under 35 U.S.C. 112, second paragraph (internal citations omitted). Acceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed, in light of the specification.

As noted in the M.P.E.P., the Federal Circuit held that "the limitation 'which produces substantially equal E and H plane illumination patterns' was definite because one of ordinary

skill in the art would know what was meant by 'substantially equal.'" M.P.E.P. § 2173.05(b), 8th Ed., Rev. 6 (September 2007) (quoting *Andrew Corp. v. Gabriel Electronics*, 847 F.2d 819, 6 USPQ2d 2010 (Fed. Cir. 1988)).

In this case, the recitation in claim 21 of an activity that is performed "at substantially the same time that the out-of-band message is communicated" is definite. Likewise, the recitation in claim 52 of "a depiction of the avatar in the form that is substantially similar to a trading card" is definite under section 112.

Applicants submit that one of ordinary skill in the art would be able to ascertain the meaning of "substantially" in claims 21 and 52 from the claim language itself in light of the specification, irrespective of whether a standard or definition is explicitly stated in the specification or the claim. *See* M.P.E.P. § 2173.02 and § 2173.05(b). As with the recitation of "substantially equal," one of ordinary skill in the relevant art would understand the meaning of the terms "substantially the same time" and "substantially similar." *See* M.P.E.P. § 2173.05(b).

The Office Action asserts that "substantially the same time" could mean "exactly the same time or a 10 [minute] . . . delay." Office Action, pp. 2, 15. Applicants submit that a skilled artisan would understand what is meant by "substantially the same time" in claim 21. The term "substantially the same" has a well-recognized and discernible meaning, and the Office Action offers no evidence or explanation, beyond conjecture, to show why one of ordinary skill in the art would not be reasonably apprised of its meaning. *See* M.P.E.P. § 2173.02. Even if "substantially the same time" were construed to include a 10 minute delay, the Office Action offers no explanation as to why this term would be indefinite.

Applicants submit that claims 21 and 52 are fully compliant with section 112, second paragraph, and thus respectfully request withdrawal of the rejection.

### **Section 103 rejection based on *Liles* and *Tang***

The section 103 rejection of claims 1-4, 7, 8, 18-32, 35-43, 47-55, 57, 58, 60-64, 66-67 and 69-84 should be withdrawn because *Liles* and *Tang* fail to support a conclusion of obviousness with respect to Applicants' claims.

Independent claim 1 recites a combination including:

graphically representing, with an avatar capable of being animated,  
a first user in a communication session involving the first user and  
a second user;

receiving, independently of the first user and the message, out-of-  
band information related to a context of the first user; and

communicating, based on stored data associations, the out-of-band  
information to the second user using a change in the avatar  
appearance or avatar animation as a communication conduit, the  
change being independent of a background display.

*Liles* does not disclose or suggest the combination recited in claim 1, including at least the  
“receiving” and “communicating” features noted above.

*Liles* is directed to animating avatars. *See* Abstract. *Liles* discloses that a user can select  
an animation of an avatar that conveys a desired emotion and/or state of mind to another user in a  
chat session. *See* col. 3, lines 28-42. *Liles* discloses that a selected animation can be selectively  
displayed in combination with a textual message transmitted by the participant. *See* col. 3, lines  
32-41. *Liles* also describes that a user can select avatar animations that convey gestures (e.g.,  
checking a watch) for display to other users in a chat session. *See* col. 7, lines 18-42; col. 9, lines  
55-65.

*Liles* nowhere discloses or suggests receiving, independently of the first user and the  
message, out-of-band information related to a context of the first user and communicating, based  
on stored data associations, the out-of-band information to the second user using a change in the  
avatar appearance or avatar animation as a communication conduit, the change being  
independent of a background display. Indeed, the Office Action acknowledges these deficiencies  
in *Liles*. *See* Office Action, pp. 3-4.

*Tang* fails to cure *Liles*'s deficiencies. *Tang* discloses a mechanism for enabling users to  
“know which other users are ‘nearby’ in terms of the type of work they are doing.” Col. 3, lines  
31-42. *Tang*'s system provides a visual/aural cue of this “task proximity” using an icon (22)  
appearing in an “encounter window” (20) of a user interface. Col. 5, lines 3-11; *see* Fig. 1.

Although *Tang* discloses providing a visual/aural cue of task proximity, the reference does not disclose or suggest at least the “communicating” feature of claim 1. For example, even if *Tang*’s “task proximity” information were construed as “out-of-band information,” *Tang* still fails to disclose or suggest communicating that task proximity information using a change in an avatar appearance or avatar animation, where the avatar is capable of being animated, as required by claim 1. Indeed, *Tang* does not disclose or suggest that the icon (22) used for indicating task proximity is “capable of being animated.” *Tang* merely discloses a “visual transformation” of the icons, which may include “a fade, wipe, dissolve, pull, or other gradual visual effects that place and remove the icons 22.” Col. 7, lines 55-65. An icon capable of being added and removed, as disclosed by *Tang*, does not by itself constitute an avatar capable of being animated, as required by claim 1.

For at least the foregoing reasons, *Liles* and *Tang*—whether taken alone or in any combination—fail to disclose or suggest each and every feature of claim 1. Moreover, no basis has been established for “concluding that it would have been obvious to one of ordinary skill in the art to bridge the gap.” M.P.E.P. § 2143.01 (VI), 8<sup>th</sup> Ed., Rev. 6 (September 2007). Indeed, the applied references do not provide such a basis. The section 103 rejection of claim 1 should accordingly be withdrawn. The section 103 rejection of dependent claims 2-4, 7, 8, 18-32, 35-43, 47-53 and 76-78 should be withdrawn as well, at least because these claims depend upon claim 1.

Moreover, the section 103 rejection of dependent claims 7, 8 and 18 should be withdrawn for at least the following additional reasons.

Dependent claim 7 recites a combination including receiving, independently of the first user and the message, out-of-band information related to a context of the first user, where the out-of-band information comprises information indicating a personality characteristic associated with the first user. In rejecting claim 7, the Office Action cites to *Liles*’s disclosure of a character selection dialog box that enables a user to select an avatar for represent the user in an on-line chat. See Office Action, p. 5.

Even if the character selection disclosed by *Liles* were construed as information indicating a “personality characteristic,” *Liles* still fails to disclose or suggest the “receiving”

feature of claim 7. Indeed, the out-of-band information indicating a personality characteristic recited in dependent claim 7 corresponds to the out-of-band information recited in claim 1 and therefore is received "independently of the first user and the message," as recited in claim 1. *Liles* does not disclose or suggest receiving a character selection "independently of the first user and the message," as claimed.

*Tang*, like *Liles*, fails to disclose or suggest receiving, independently of the first user and the message, information indicating a personality characteristic associated with the first user, as required by dependent claim 7. *Tang* merely discloses providing an indication of "which other users are 'nearby' in terms of the type of work they are doing." *Tang*'s "task proximity" information does not constitute information indicating a personality characteristic, as recited in dependent claim 7.

Dependent claim 8 recites, *inter alia*, receiving, independently of the first user and the message, out-of-band information related to a context of the first user, where the out-of-band information comprises information indicating an emotional state associated with the first user. In rejecting claim 8, the Office Action cites to *Liles*'s disclosure regarding a user selecting an avatar gesture that conveys a personality trait and/or an emotion. *See* Office Action, p. 5. Although *Liles* discloses personality traits and emotions, the reference still fails to disclose or suggest the "receiving" feature of claim 8. The out-of-band information indicating an emotional state recited in dependent claim 8 corresponds to the out-of-band information recited in claim 1 and therefore is received "independently of the first user and the message," as recited in claim 1. *Liles* does not disclose or suggest receiving information indicating an emotional state "independently of the first user and the message," as claimed. Instead, *Liles* merely discloses a user selecting a gesture.

*Tang*, like *Liles*, fails to disclose or suggest receiving, independently of the first user and the message, information indicating an emotional state associated with the first user, as required by dependent claim 8. *Tang*'s "task proximity" information does not constitute information indicating an emotional state, as recited in claim 8. *Tang* merely describes information indicating "which other users are 'nearby' in terms of the type of work they are doing."

Dependent claim 18 recites receiving, independently of the first user and the message, out-of-band information related to a context of the first user, where out-of-band information

comprises information related to a mood of the first user. In rejecting claim 18, the Office Action cites again to *Liles*'s disclosure regarding a user selecting an avatar gesture that conveys a personality trait and/or an emotion. *See* Office Action, p. 5.

Even if *Liles* were to disclose information related to a user mood, the reference still fails to disclose or suggest the "receiving" feature of claim 18. The out-of-band information related to a mood of the user recited in dependent claim 8 is received "independently of the first user and the message." *Liles* does not disclose or suggest receiving information related to a mood of the user "independently of the first user and the message," as claimed. *Liles* merely discloses a user selecting a gesture.

*Tang* also fails to disclose or suggest receiving, independently of the first user and the message, information related to a mood of the first user, as required by dependent claim 18. *Tang*'s "task proximity" information does not constitute information related to a mood of the user, as recited in claim 18. *Tang* merely describes information indicating "which other users are 'nearby' in terms of the type of work they are doing." *Tang* does not disclose or suggest that such information is related to a mood of the user.

For at least these additional reasons, *Liles* and *Tang*—whether taken alone or in any combination—fail to disclose or suggest each and every feature of claims 7, 8 and 18. These references also fail to provide a basis for concluding that it would have been obvious to a skilled artisan to bridge the gap between the applied references and Applicants' claims. The section 103 rejection of dependent claims 7, 8 and 18 should accordingly be withdrawn.

Independent claims 54, 63 and 72, although different in scope from claim 1 and each other, recite subject matter similar to that in claim 1 discussed above. For at least reasons similar to those presented above in connection with claim 1, the section 103 rejection of independent claims 54, 63 and 72 should be withdrawn. The section 103 rejection of dependent claims 55, 57, 58, 60-62, 64, 66, 67, 69-75 and 79-84 should be withdrawn as well, since each of these claims depends upon claim 54, 63 or 72.

Moreover, each of dependent claims 57, 58, 60, 66, 67 and 69 recites subject matter similar to that recited in one of dependent claims 7, 8 and 18. For at least reasons similar to the

additional reasons presented above in connection with claims 7, 8 and 18, the section 103 rejection of claims 57, 58, 60, 66, 67 and 69 should be withdrawn.

Applicants accordingly request withdrawal of the section 103 rejection and the timely allowance of claims 1-4, 7, 8, 18-32, 35-43, 47-55, 57, 58, 60-64, 66-67 and 69-84.

**Section 103 rejection based on *Liles, Tang and Kim***

Each of claims 5, 6, 9-17, 56, 59, 65 and 68 depends upon claim 1, 54 or 63. As discussed above, *Liles* and *Tang* fail to disclose or suggest each and every feature of claims 1, 54 and 63. *Kim*, which was applied to certain features of dependent claims 5, 6, 9-17, 56, 59, 65 and 68, relates to changing a screen image containing an avatar acting in a virtual space and a background image. *See* Abstract. *Kim* describes determining a user's location, retrieving a predefined screen image based on the location, and transmitting the screen image to a client device for display to the user and modification by the user. *See* page 5; *see* also Fig. 2.

Although *Kim* describes changing a screen image containing an avatar, *Kim* fails to cure the deficiencies of *Liles* and *Tang* with respect to independent claims 1, 54 and 63. *Kim* further fails to provide a basis for concluding that it would have been obvious to a skilled artisan to bridge the gap between the applied references and Applicants' claims. Accordingly, *Liles, Tang* and *Kim*—whether taken alone or in any combination—fail to render obvious claim 1, 54 or 63 or any of their respective dependent claims 5, 6, 9-17, 56, 59, 65 and 68. Applicants therefore request withdrawal of the section 103 rejection and the timely allowance of dependent claims 5, 6, 9-17, 56, 59, 65 and 68.

**Section 103 rejection based on *Liles, Tang and Matsuda***

Claims 33 and 34 depend upon claim 1. As discussed above, *Liles* and *Tang* fail to disclose or suggest each and every feature of claim 1. *Matsuda*, which was applied to certain features of claims 33 and 34, discloses a system that converts character data constituting a chat into audio data, which is output as a voice of an avatar. *See* Abstract; col. 1, lines 5-12; col. 10, lines 10-12. *Matsuda* does not cure the deficiencies of *Liles* and *Tang* with respect to independent claim 1 and fails to provide a basis for concluding that it would have been obvious to a skilled artisan to bridge the gap between the applied references and Applicants' claims.

Accordingly, *Liles*, *Tang* and *Matsuda*—whether taken alone or in any combination—fail to render obvious claim 1 or its dependent claims 33 and 34. Applicants therefore request withdrawal of the section 103 rejection and the timely allowance of dependent claims 33 and 34.

**Section 103 rejection based on *Liles*, *Tang* and *Ostermann***

Claims 44-46 depend upon claim 1. As discussed above, *Liles* and *Tang* fail to disclose or suggest each and every feature of claim 1. *Ostermann*, which was applied to certain features of claims 44-46, relates to customizing multi-media messages. See Abstract; col. 1, lines 35-42. As noted in the Office Action, *Ostermann* describes accessorizing an animated entity, for example, with sunglasses. See Office Action, p. 14; see *Ostermann*: col. 11, line 60 – col. 12, line 8.

*Ostermann* does not cure the deficiencies of *Liles* and *Tang* with respect to independent claim 1. For example, *Ostermann* does not disclose or suggest receiving, independently of a user and communicated message, out-of-band information indicating that the user is in a sunny location or is wearing sunglasses and then accessorizing the animated entity with sunglasses to communicate the out-of-band information based on stored data associations. *Ostermann* further fails to provide a basis for concluding that it would have been obvious to a skilled artisan to bridge the gap between the applied references and Applicants' claims. Accordingly, *Liles*, *Tang* and *Ostermann*—whether taken alone or in any combination—fail to render obvious claim 1 or its dependent claims 44-46. Applicants therefore request withdrawal of the section 103 rejection and the timely allowance of dependent claims 44-46.

**Conclusion**

Applicants request the Examiner's reconsideration of the application in view of the foregoing and the timely allowance of pending claims 1-84.

It is believed that all pending issues in the outstanding Office Action have been addressed by this paper. The Office Action, however, contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether or not any such statement is identified herein, Applicants decline to automatically subscribe to any statement or



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characterization in the Office Action. In addition, there may be reasons for patentability of any or all pending or other claims that have not been expressed above.

If there are any questions regarding this paper or the application generally, Applicants would appreciate a telephone call to the undersigned since this may expedite prosecution of the application.

Please grant any extensions of time required to enter this paper and apply any required charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

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